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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,952	12/28/2000	Douglas B. Quine	F-234	7540

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PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER	
SALAD, ABDULLAHI ELMI	

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,952	QUINE ET AL.	
	Examiner	Art Unit	
	Salad E Abdullahi	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4,5,9,10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 11-69 are pending. The rejection cited stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 42, 44 and 45 recite the limitation "the first electronic location" in lines 3, 2 and 3 respectively. There is insufficient antecedent basis for this limitation in the claims.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor " (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 20 and 21 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of copending Application No. 09/751,490.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claim 20 of the instant application is compared to claim 1 of the co-pending application in the table below.

Co-pending Application 09/751,490	Instant Application 09/750,952
Claim 1: a method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer having a unique e-mail address, the method comprising the steps of:	Claim 20: a method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer having a unique e-mail address, the method comprising the steps of:
prescribing at least one domain name **address** in the remote e-mail forwarding computer by a subscriber;	prescribing at least one domain name in the remote e-mail forwarding computer by a subscriber;
prescribing at least one format for formatting e-mail addresses intended to be sent to the at least one domain name **address**;	prescribing at least one format for formatting e-mail addresses intended to be sent to the at least one domain name;
sending from a user to the remote computer an e-mail message addressed to an intended e-mail address;	sending from a user to the remote computer an e-mail message addressed to an intended e-mail address;
receiving at the remote computer from a senders computer the e-mail message addressed to the intended e-mail address;	receiving at the remote computer from a senders computer the e-mail message addressed to the intended e-mail address;
parsing the intended e-mail address from the e-mail message in the remote computer to determine if the domain name **address** of the e-mail message has been prescribed with the remote computer; and	parsing the intended e-mail address from the e-mail message in the remote computer to determine if the domain name of the e-mail message has been prescribed with the remote computer; and
sending a message to the senders computer indicating the prescribed at	sending a message to the senders computer indicating the prescribed at

least one format for the parsed domain name address if the parsed domain name **address** has been prescribed with the remote computer.	least one format for the parsed domain name address if the parsed domain name has been prescribed with the remote computer.

As shown in the above table the word "**address**" was removed from claim 1, of the instant application:

However, domain name address as used in the instant application claim 20 is synonymous with domain name as used in claim 1 of the co-pending application and the two phrases are interchangeable used in instant application and in the art as a whole. Therefore, Claim 20 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of the co-pending Application No. 09/751-490.

7. Claim 21 of the instant application is compared with claim 2 of the co-pending application on the table below.

Co-pending Application 09/751,490	Instant Application 09/750,952
Claim 2: a method as recited in claim 1 further including the step of prescribing a plurality of correct usernames for the prescribed domain name **address** in the remote computer.	Claim 21: a method as recited in claim 20 further including the step of prescribing a plurality of correct usernames for the prescribed domain name in the remote computer.

As show above in the above table the only difference between claim 21 of the instant application and claim 2 of the co-pending application is that, the word "address" was removed to claim 21of the instant application.

However, domain name address as used in the instant application claim 21 is synonymous with domain name as used in claim 2 of the co-pending application and the two phrases are interchangeable used in instant application and in the art as a whole. Therefore, Claim 21 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2of copending Application No. 09/751-490.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 22 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3of copending Application No. 09/750,952. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the two claims is that "intended e-mail address" is recited in the claim 22 of the instant application instead of "username associated with the e-mail message" is recited in claim 3 of the co-pending application.

10. Claim 22 of the instant application is compared with claim 3 of the co-pending application on the table below.

Co-pending Application 09/751,490	Instant Application 09/750,952
Claim 3: a method as recited in claim 2 further including the step of determining in the remote computer if there is a closest match between one of the prescribed correct usernames with that of the **username associated with the e-mail message** sent to the remote computer	Claim 22: a method as recited in claim 21 further including the step of determining in the remote computer if there is a closest match between one of the prescribed correct usernames with that of the **intended e-mail address** sent to the remote computer.

As shown in the above table the only difference between the two claims is that username associated with the e-mail message is added to claim 3 of the co-pending application.

However, the username associated with e-mail message as recited claim 3 of the instant application is analogous with the intended e-mail address which includes a username of the intended e-mail address. Therefore, a person having ordinary skill in the art would have readily recognized the username associated with e-mail address as recited in claim 3 of the co-pending application is obviously the intended e-mail address as recited in claim 22 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 33-36, 38-48, 50-55 and 57-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Tusei.

As to claim 33, Tusei discloses a method for transmitting electronic data comprising:

receiving electronic data that includes non-preferred electronic address data at an intermediate address (old ISP) (see fig. 4 and col. 9, lines 19-25);

determining whether the non-preferred electronic address data is associated with a preferred electronic address (see col. 9, lines 26-31).

As to claim 34, Tusei discloses the method as claimed in claim 33 further comprising transmitting the electronic data from the intermediate address to the preferred electronic address when it is determined that the non-preferred electronic data is associated with preferred electronic address data (see col. 9, lines 49-64).

As to claim 35, Tusei discloses the method as recited in claim 33 wherein if there is not a preferred electronic address associated with the non-preferred electronic address data, further including the step of determining if there is a closest match electronic address between the non-preferred electronic address data and a username registered with the intermediate address (see col. 9, lines 65 to col. 10, lines 6).

As to claim 36, Tusei discloses a method as recited in claim 35 further including the step of sending the closest match electronic address to the sender if it is determined that there is a closest match (see col. 10, lines 25-31).

As to claim 38, Tusei discloses a method as recited in claim 34 further including the step of sending a confirmation electronic message to the sender address indicating that the electronic data has been sent to the preferred electronic address (see col. 9, lines 49-64).

As to claim 39,Tusei discloses a method as recited in claim 34 further including the step of sending an electronic message fro the sender address indicating that the electronic data has not been sent to the preferred electronic address (see col. 9, lines 39-52)..

As to claim 40, Tusei discloses a method as recited in claim 34 further comprising the step of comparing the non-preferred electronic address data to a look-up table (see coi. 9, lines 59-64).

As to claim 41, Tusei discloses a method for transmitting electronic data comprising: receiving electronic data at an intermediate electronic location (OLD ISP), the electronic data including incorrect recipient address data (see fig. 4 and col. 9, lines 19-25); determining if the incorrect recipient address data matches an electronic recipient address(see col. 9, lines 26-31); and
if a match is determined, transmitting the electronic data to the electronic recipient address (see col. 9, lines 26-38).

As to claim 42, Tusei discloses the method as claimed in claim 41, further comprising the step of transmitting a response message from the intermediate electronic location to a first electronic location (i.e., first sender location) (see col. 9, lines 26-38).

As to claim 43, Tusei discloses the method as claimed in claim 42 wherein the response message includes correct electronic recipient address data (see col. 9, lines 26-38).

As to claim 44, Tusei discloses the method as claimed in claim 41, further comprising: if a match is not determined, transmitting a message to the first electronic location that the electronic data was not transmitted to the electronic recipient address (see col. 9, lines 49-52).

As to claim 45, Tusei discloses the method as claimed in claim 41, further comprising: transmitting a message from the intermediate electronic location to the first electronic location that includes format data (see col. 9, lines 49-52).

As to claim 46, Tusei discloses an apparatus for transmitting electronic data comprising: a processing facility (EAMS 300) coupled to one or more devices (112 and 150) the processing facility adapted to receive electronic data from a sender (see col. 9, lines 59-60), the electronic data including non-preferred electronic address data (i.e., OLD e-mail address), the processing facility adapted to correlate the non-preferred electronic address data to preferred electronic address data (new e-mail address), wherein the processing facility is adapted to transmit electronic message data to the preferred electronic address and provide the sender with status information (see fig. 3, element 330 and col. 9, line 59 to col. 10, line 24).

As to claim 47, Tusei discloses the apparatus recited in claim 46 wherein the processing facility is adapted to determine if there is a closest match between the non-preferred electronic address and a username registered with the processing facility (see col. 9, line 59 to col. 10, line 24).

As to claim 48, Tusei discloses the apparatus as recited in claim 47 wherein the processing facility is adapted to send the closest match username to the sender if it is determined that there is a closest match (col. 9, line 59 to col. 10, line 37).

As to claim 50, Tusei discloses he apparatus as recited in claim 46, wherein the processing facility is adapted to send a confirmation electronic message to the sender indicating that the electronic data has been sent to the preferred electronic address (col. 9, line 59 to col. 10, line 37).

As to claim 51, Tusei discloses the apparatus as recited in claim 46, wherein the processing facility is adapted to send an electronic message to the sender indicating that the electronic data has not been sent to the preferred electronic address (col. 9, line 59 to col. 10, line 37).

As to claim 52, Tusei discloses a method for transmitting electronic data that includes a non-preferred electronic address, the method comprising the steps of:

transmitting a modified email message from a location associated with the non-preferred electronic address to the sender location (see col. 9, lines 49-52) , wherein the modified email message includes an indication that the original email message was not delivered to the non-preferred electronic address (see col. 9, lines 49-52); and transmitting the modified email message and non-preferred electronic address data from the sender location to an intermediate location (see col. 9, lines 53-64).

As to claim 53, Tusei discloses the method as recited in claim 52 further comprising determining whether the non-preferred electronic address data is associated with a preferred electronic address (see col. 9, lines 59-64).

As to claim 54, Tusei discloses the method as recited in claim 53 further comprising transmitting electronic data from the intermediate location to the preferred electronic address (see col. 9, lines 54-64).

As to claim 55, Tusei discloses the method as recited in claim 53, further comprising transmitting a status message from the intermediate location to the sender indicative of the status of the determination (see col. 10, lines 7-12).

As to claim 57, Tusei discloses the method as recited in claim 53, further comprising transmitting the preferred electronic address from the intermediate location to the sender (see col. 10, lines 13-24).

As per claim 58, Tusei discloses a method for transmitting electronic data comprising: receiving electronic data at a selected location (EAMS 330) from a sender (112) (see col. 9, lines 59-64);

parsing the electronic data to obtain non-preferred electronic address data(see col. 9, lines 59-64); and

determining whether there is a preferred electronic address associated with the non-preferred electronic address data(see col. 9, lines 59-64).

As to claim 59, Tusei discloses the method as recited in claim 58, further comprising transmitting the preferred electronic address from the selected location to the sender (see col. 10, lines 25-31);

As to claim 60, Tusei discloses the method as recited in claim 58, further comprising transmitting a status report from the selected location to the sender (see col. 10, lines 7-11).

As to claim 61, Tusei discloses the method as recited in claim 58, further comprising transmitting the electronic data from the selected location to the preferred electronic address (see col. 10, lines 32-37).

As to claim 62, Tusei discloses a method for transmitting electronic data comprising:

receiving electronic data at a selected location from a sender (see col. 9, lines 59-64);

parsing the electronic data to obtain non-preferred electronic address data (see col. 9, lines 59-64); and

determining whether there is a closest match to the non-preferred electronic address data (see col. 9, lines 59-64).

As to claim 63, Tusei discloses the method as recited in claim 62, further comprising transmitting the preferred electronic address from the selected location to the sender (see col. 10, lines 25-31).

As claim 64, Tusei discloses the method as recited in claim 62, further comprising transmitting a status report from the selected location to the sender (see col. 10, lines 7-11).

As to claim 65, Tusei discloses the method as recited in claim 62, further comprising transmitting the electronic data from the selected location to the preferred electronic address (see col. 10, lines 32-37).

As to claim 66, Tusei discloses a method for transmitting electronic data comprising:

receiving electronic data at a selected location from a sender(see col. 9, lines 59-64);

parsing the electronic data to obtain non-preferred electronic address data(see col. 9, lines 59-64); and

determining whether the non-preferred electronic address data corresponds to a format (i.e., username@newisp.com) registered with the selected location (see fig. 3 and col. 9, lines 59-64).

As to claim 67, Tusei discloses the method as recited in claim 66, further comprising transmitting the format from the selected location to the sender (see col. 10, lines 25-31).

As to claim 68, Tusei discloses the method as recited in claim 66, further comprising transmitting a status report from the selected location to the sender (see col. 10, lines 7-12).

As to claim 69, Tusei discloses the method as recited in claim 66, further comprising transmitting the electronic data from the selected location to an electronic address corresponding to the format (see col. 10, lines 25-31).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 11-14, 16-27 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tusei U.S. Patent No. 6,654,779[hereinafter Tsuei] in view of Reilly U.S. Patent No. 6,427,164[hereinafter Reilly].

As per claim 11, Tsuei discloses a method for transmitting an e-mail message to a preferred e-mail address that has been sent from a sender address to a second address, the method comprising the steps of:

- receiving the e-mail message at the second address (the EMAS 330 receiving from senders 110 an e-mail message with an old e-mail address) (see col. 7, lines 9-14);
- parsing non-preferred e-mail address from the e-mail message at the second address and determining if there is a preferred e-mail address associated with the non-preferred e-mail address computer (looking up the old e-mail address from the bounced/undeliverable e-mail message) (see col. 7, lines 9-16 and col. 8, lines 5-17);
- if yes, sending the e-mail message from the second address to the preferred e-mail address (i.e. username followed by domain address as shown on the new e-mail address returned by the EMAS 300) (see col. 7, lines 9-24).

Tsuei, does not explicitly disclose:

if no, parsing the non-preferred e-mail address to extract the domain name and determining if the domain name has been registered with the second address.

Nonetheless, determining if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer is well known in the art and would have been an obvious modification to Tusei's system as evidenced by Reilly. Reilly, discloses after an e-mail servers receive an intended e-mail address from an e-mail message, the e-mail servers first parse or check the domain name address of the received e-mail message in a database (that is the data after the sign @, or the domain name address portion of the e-mail) to determine if it is the proper destination (i.e., if the domain name address is registered with e-mail server) before taking any other action (see col. 7, lines 7-13). The advantage of parsing the domain name address first of the e-mail message is to determine quickly if domain name address (e.g. OLDISP.com) is known to the e-mail server. Furthermore, Tsuei teaches in response to receiving e-mail message containing predetermined e-mail address the EAMS 330 can lookup or parse the e-mail address in the database 38 to determine if intended e-mail address of the e-mail message is associated with a new e-mail address in its database records which obviously includes checking the domain name address portion of the intended e-mail address to determine if the domain name is registered with the EMAS system. Hence, one skilled in the art would have readily recognized by looking up the e-mail addresses in the database 338 in order to determine if the intended e-mail address is associated with any of the e-mail address in its database Tsuei determines if the domain name address of intended e-mail address from e-mail message has been prescribed with the

remote computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Reilly into Tsuei's system such that the EMAS server 300 can lookup the domain name address of the e-mal messages to determine if it is the proper destination of the e-mail message in order to quickly and efficiently processes the e-mail message, thereby enhancing system response time.

As per claim 12, Tusei discloses the method as recited in claim 1 further comprising, determining if a list of usernames of the parsed domain name has been registered with the second address (see fig. 3, elements 340a –340n, which shows a plurality of correct usernames of the domain OLDISP.com and col. 6, lines 31-37).

As to claim 13, Tusei discloses the method as recited in claim11 further including the step of determining if there is a closest match between the non-preferred e-mail address and any username registered with the second address (see col. 9, line 9, lines 59-64, where the EAMS searches its database 338 to determine if there is match between records database i.e., usernames associated with e-mail address in the data database with the e-mail messages).

As to claim 14, Tusei discloses the method as recited in claim 13 further including the step of sending the closest match username to the sender address if it is determined that there is a closest match (see col. 9, lines 59-64).

As to claim 16, Tusei discloses a method as recited in claim 11 further including the step of sending an e-mail message to the sender address from the second address indicating that the e-mail has been sent to the preferred e-mail address (see col. 9, line 9, lines 59-64).

As to claim 17, Tusei discloses a method as recited in claim 11 further including the step of sending an e-mail message to the sender address from the second address indicating that the e-mail message was not forwarded if the preferred e-mail address is not associated with the non-preferred e-mail address (see col. 10, lines 7-12).

As to claim 18, Tusei discloses a method as recited in claim 11 wherein the parsing step includes the step of comparing the non-preferred e-mail address to a look-up table to determine if the non-preferred e-mail address is contained in the look-up table (see fig. 2, and 7, lines 9-18).

As to claim 19, Tusei discloses a method as recited in claim 11 further including the steps of:

receiving a response message at the second address indicating that the e-mail message was not delivered to the non-preferred email address; and

relaying the response message from the second address to the sender address (see col. 10, lines 7-12).

As per claim 20, Tsuei discloses a method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer (e-mail address management EAMS 330) having a unique e-mail address, the method comprising the steps of:

- prescribing at least one domain name address in the remote e-mail forwarding computer by a subscriber (registering at least domain name address e.g. OLDISP.com in the EAMS 330 by a recipient 150) (see fig. 3, element 342 and col. 6, lines 17-44).
- prescribing at least one format for formatting e-mail addresses intended to be sent to the at least one domain name address (registering by the recipient 150 the format for the e-mail address e.g. username followed by domain name/ username@OLDISP.COM as shown by 342)(see fig. 3, element 344 and col. 6, lines 17-44);
- sending from a user (sender 110) to the remote computer (EAMS) an e-mail message addressed to an intended e-mail address (old e-mail address) (see fig. 3, element 342 and col. 7, lines 53-57, where a sender 110 sends an e-mail message with an old e-mail address);
- receiving at the remote computer (EAMS 300) from a senders computer the e-mail message addressed to the intended e-mail address (the EMAS 330 receiving from senders 110 an e-mail message with an old e-mail address) (see col. 7, lines 9-14);

- parsing the intended e-mail address from the e-mail message in the remote computer (looking up the old e-mail address from the bounced/undeliverable e-mail message)(see col. 7, lines 9-16 and col. 8, lines 5-17); and
- sending a message to the senders computer indicating the prescribed at least one format (i.e. username followed by domain address as shown on the new e-mail address returned by the EMAS 300) (see col. 7, lines 9-24).

Tsuei, does not explicitly disclose:

determining if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer.

Nonetheless, determining if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer is well known in the art and would have been an obvious modification to Tusei's system as evidenced by Reilly. Reilly, discloses after an e-mail servers receive an intended e-mail address from an e-mail message, the e-mail servers first parse or check the domain name address of the received e-mail message in a database (that is the data after the sign @, or the domain name address portion of the e-mail) to determine if it is the proper destination (i.e., if the domain name address is registered with e-mail server) before taking any other action (see col. 7, lines 7-13). The advantage of parsing the domain name address first of the e-mail message is to determine quickly if domain name address (e.g. OLDISP.com) is known to the e-mail server. Furthermore, Tsuei teaches in response to receiving e-mail message containing predetermined e-mail address the EAMS 330 can lookup or parse the e-mail address in the database 38 to determine if intended e-mail address of the e-

mail message is associated with a new e-mail address in its database records which obviously includes checking the domain name address portion of the intended e-mail address to determine if the domain name is registered with the EMAS system. Hence, one skilled in the art would have readily recognized by looking up the e-mail addresses in the database 338 in order to determine if the intended e-mail address is associated with any of the e-mail address in its database Tsuei determines if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Reilly into Tsuei's system such that the EMAS server 300 can lookup the domain name address of the e-mal messages to determine if it is the proper destination of the e-mail message in order to quickly and efficiently processes the e-mail message, thereby enhancing system response time.

As per claim 21, Tusei discloses the method as recited in claim 1 further including the step of prescribing a plurality of correct usernames for the prescribed domain name address in the remote computer (see fig. 3, elements 340a –340n, which shows a plurality of correct usernames of the domain OLDISP.com and col. 6, lines 31-37).

As per claim 22, Tusei discloses the method as recited in claim 2 further including the step of determining in the remote computer if there is a closest match between one of the prescribed correct usernames with that of the username associated with the e-mail

message sent to the remote computer (see col. 9, line 9, lines 59-64, where the EAMS searches its database 338 to determine if there is match between records database i.e., usernames associated with e-mail address in the data database with the e-mail messages).

As to claim 23, Tusei discloses a method for forwarding an undeliverable e-mail message comprising the steps of:

receiving an e-mail message, from a first electronic location referencing a

- first e-mail address, at a second electronic location(see col. 7, lines 9-14);
- parsing the referenced e-mail address from the e-mail message at the second electronic location to determine if there is a second e-mail address
- associated with the referenced e-mail address(see col. 7, lines 9-16 and col. 8, lines 5-17);
- if yes, sending the e-mail message from the second electronic location to a third electronic location associated with the second e-mail address(i.e. username followed by domain address as shown on the new e-mail address returned by the EMAS 300) (see col. 7, lines 9-24).

Tsuei, does not explicitly disclose:

if no, parsing the referenced e-mail address to extract the domain name from the referenced e-mail address to determine if the domain name of the referenced e-mail address has been registered with the second electronic location.

Nonetheless, determining if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer is well known in the art and would have been an obvious modification to Tusei's system as evidenced by Reilly. Reilly, discloses after an e-mail servers receive an intended e-mail address from an e-mail message, the e-mail servers first parse or check the domain name address of the received e-mail message in a database (that is the data after the sign @, or the domain name address portion of the e-mail) to determine if it is the proper destination (i.e., if the domain name address is registered with e-mail server) before taking any other action (see col. 7, lines 7-13). The advantage of parsing the domain name address first of the e-mail message is to determine quickly if domain name address (e.g. OLDISP.com) is known to the e-mail server. Furthermore, Tsuei teaches in response to receiving e-mail message containing predetermined e-mail address the EAMS 330 can lookup or parse the e-mail address in the database 38 to determine if intended e-mail address of the e-mail message is associated with a new e-mail address in its database records which obviously includes checking the domain name address portion of the intended e-mail address to determine if the domain name is registered with the EMAS system. Hence, one skilled in the art would have readily recognized by looking up the e-mail addresses in the database 338 in order to determine if the intended e-mail address is associated with any of the e-mail address in its database Tsuei determines if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Reilly into Tsuei's

system such that the EMAS server 300 can lookup the domain name address of the e-mal messages to determine if it is the proper destination of the e-mail message in order to quickly and efficiently processes the e-mail message, thereby enhancing system response time.

As to claim 24, Tusei discloses the method as claimed in claim 23, further comprising the step of determining if a list of usernames for the parsed domain name has been registered with the second electronic location (see fig. 3, elements 340a –340n, which shows a plurality of correct usernames of the domain OLDISP.com and col. 6, lines 31-37).

As to claim 25, Tusei discloses a method as recited in claim 24 further including the step of determining if there is a closest match between the username of the e-mail and with any username registered with the second electronic location (see col. 9, line 9, lines 59-64, where the EAMS searches its database 338 to determine if there is match between records database i.e., usernames associated with e-mail address in the data database with the e-mail messages).

As to claim 26, Tusei discloses method as recited in claim 25 further including the step of sending the closest match username to a user of the first electronic location if it is determined that there is a closest match between the username of the e-mail message

and with the usernames registered with the second electronic location (see col. 9, lines 59-64).

As to claim 27, Tusei discloses a method as recited in claim 23, further including the step of forwarding the email message from the second electronic location to the third electronic location without notifying a user at the first electronic location of the second email address (see col. 10, lines 7-24).

As to claim 29, Tusei discloses a method as recited in claim 23 further including the step of sending an e-mail message to the first electronic location from the second electronic location indicating that the e-mail has been sent to the second e-mail address (see col. 9, line 9, lines 59-64).

As to claim 30, Tusei discloses a method as recited in claim 23 further including the step of sending an e-mail message to the first electronic location from the second electronic location indicating that the e-mail message was not forwarded to the second e-mail address if the second e-mail address is not associated with the referenced e-mail address(see col. 10, lines 7-12).

As to claim 31, Tusei discloses a method as recited in claim 23 wherein the parsing step includes the step of comparing the referenced e-mail address to a look-up table to

determine if the referenced e-mail address is contained in the look-up table (see fig. 3, element 338 and col. 7, lines 9-18).

As to claim 32, Tusei discloses a method as recited in claim 23 further including the steps of:

receiving a response message at the second electronic location from the third electronic location indicating that the e-mail message was not delivered to the third electronic location (see col. 10, lines 7-24); and

relaying the response message from the second electronic location to the first electronic location(see col. 10, lines 7-24).

15. Claims 15 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tusei and Reilly and further in view of Bliss et al., U.S. Patent No. 6,654,789[hereinafter Bliss].

As to claim 15, Tusei and Reilly disclose substantial features of the claimed as discussed above with respect to claim 14,

Tusei and Reilly are silent regarding:

> the step of sending a suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match.

Bliss discloses an electronic mail management system for storing an old and new electronic identifiers for electronic mail including the step of sending suggested format

for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match (i.e., displaying or returning likely corrections of an e-mail address) (see col. 5, lines 18-38). Therefore, it would have been obvious to having ordinary skill in the art at the time of the invention to incorporate the teaching of Bliss such as sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match into the system of Tusei and Reilly in order to enable users to track old electronic mail addresses, thus enhancing system scalability.

As to claim 28, Tusei and Reilly disclose substantial features of the claimed as discussed above with respect to claim 23,

Tusei and Reilly are silent regarding:

> the step of sending a suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match.

Bliss discloses an electronic mail management system for storing an old and new electronic identifiers for electronic mail including the step of sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match (i.e., displaying or returning likely corrections of an e-mail address) (see col. 5, lines 18-38). Therefore, it would have been obvious to having ordinary skill in the art at the time of

the invention to incorporate the teaching of Bliss such as sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match into the system of Tusei and Reilly in order to enable users to track old electronic mail addresses, thus enhancing system scalability.

16. Claims 37, 49 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tusei in view of Bliss et al., U.S. Patent No. 6,654,789[hereinafter Bliss].

As to claim 37, Tusei and Reilly disclose substantial features of the claimed as discussed above with respect to claim 46,

Tusei and Reilly are silent regarding:

> the step of sending a suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match.

Bliss discloses an electronic mail management system for storing an old and new electronic identifiers for electronic mail including the step of sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match (i.e., displaying or returning likely corrections of an e-mail address) (see col. 5, lines 18-38). Therefore, it would have been obvious to having ordinary skill in the art at the time of the invention to incorporate the teaching of Bliss such as sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message

sent from the sender address if it is determined there is no closest match into the system of Tusei and Reilly in order to enable users to track old electronic mail addresses, thus enhancing system scalability.

As to claim 49, Tusei and Reilly disclose substantial features of the claimed as discussed above with respect to claim 46,

Tusei and Reilly are silent regarding:

> the step of sending a suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match.

Bliss discloses an electronic mail management system for storing an old and new electronic identifiers for electronic mail including the step of sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match (i.e., displaying or returning likely corrections of an e-mail address) (see col. 5, lines 18-38). Therefore, it would have been obvious to having ordinary skill in the art at the time of the invention to incorporate the teaching of Bliss such as sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match into the system of Tusei and Reilly in order to enable users to track old electronic mail addresses, thus enhancing system scalability.

As to claim 56, Tusei and Reilly disclose substantial features of the claimed as discussed above with respect to claim 53,

Tusei and Reilly are silent regarding:

> the step of sending a suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match.

Bliss discloses an electronic mail management system for storing an old and new electronic identifiers for electronic mail including the step of sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match (i.e., displaying or returning likely corrections of an e-mail address) (see col. 5, lines 18-38). Therefore, it would have been obvious to having ordinary skill in the art at the time of the invention to incorporate the teaching of Bliss such as sending suggested format for formatting usernames associated with the parsed domain name of the e-mail message sent from the sender address if it is determined there is no closest match into the system of Tusei and Reilly in order to enable users to track old electronic mail addresses, thus enhancing system scalability.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) McDowell et al., U.S. Patent No. 6,438,583. Provides an e-mail re-routing system, which enables a user to register with re-route server with his/her old e-mail address.

b)Salzfass et al., U.S. Patent Application Publication No. 2002/0042815. Provides an automated system for routing undeliverable e-mail messages to intended recipient.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to: **(703) (872-9306)**.

Abdullahi Salad
Examiner Au 2157
5/25/2004